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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,013	06/12/2001	Robert Carey Tucker	CL/V-32032P1	3398

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EXAMINER

SCHWARTZ, JORDAN MARC.

ART UNIT PAPER NUMBER

2873

DATE MAILED: 09/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/879,013

Applicant(s)

TUCKER, ROBERT CAREY

Examiner

Jordan M. Schwartz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23, 25, 26, 28-42 and 50-58 is/are pending in the application.
- 4a) Of the above claim(s) 17-23, 25, 26, 28-38, 40 and 42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 15, 16, 39, 41, 50-56 and 58 is/are rejected.
- 7) ☒ Claim(s) 13, 14 and 57 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of Group 1a (claims 1-16 and 50-58) in Paper No. 7 is acknowledged. Generic claim 39 (and additionally claim 41 which could be examined with the generic claim without undue burden) have been examined herein as well. Therefore, claims 1-16, 39, 41 and 50-58 have been examined herein.

### ***Claim Objections***

Claims 4, 6, 8, and 54 are objected to because of the following informalities:

1. In reference to claims 4 and 6, "5 second" should be corrected to "5 seconds";
2. In reference to claim 8, "dispensing droplets" should be corrected to "by dispensing droplets";
3. In reference to claim 54, "said cosmetic pattern" lacks an antecedent basis (since claim 52 does not definitely claim that the image is a cosmetic pattern) and for purposes of examination it is assumed that claim 54 meant to depend from claim 53 (not claim 52).

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 39 and 41 are rejected under 35 U.S.C. 102(e) as being anticipated by Doshi patent number 6,315,410.

Doshi reads on these claims by disclosing the limitations therein including the following: a method of making a colored contact lens (abstract) comprising printing at least one layer of a colorant onto a contact lens (column 14, lines 51-65); using an ink-jet printing process (column 14, lines 51-65); and the printing step comprises printing directly onto the contact lens (column 14, lines 51-65, column 19, line 54).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12, 15-16, 50-56 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doshi patent number 6,315,410 in view of Morgan et al.

Doshi discloses the limitations therein including the following: a method of making a colored contact lens (abstract); comprising transporting a colored contact lens into an ink jet printer (abstract, column 8, lines 16-28); the ink jet printer having a plurality of nozzles (column 8, lines 16-28, column 6, lines 30-48, column 18, lines 25-55); printing a first pattern onto a contact lens surface under control of a computer (column 13, lines 48-62); dispensing droplets from one or more nozzles onto the surface

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of the contact lens (column 8, lines 16-28, column 6, lines 30-48, column 13, lines 48-62, column 18, lines 25-55). It is believed that the droplets will inherently have a volume less than 100 picoliters and pixels with diameters less than 150 microns, this being reasonably based upon Doshi disclosing that the ink jet printing device can be "commercially available printing devices" (column 8, line 24) which are known to produce droplets having volumes and pixels of this size. Regardless, Doshi et al further discloses that preferred droplets are between  $1 \times 10^{-9}$  to  $1 \times 10^{-5}$  (column 8, line 12) but does not specifically disclose " $< 1 \times 10^{-10}$ " (i.e. "less than 100 picoliters" as claimed). However, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the volume of the droplets within the claimed range since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233. Furthermore, droplets with a volume less than 100 picoliters will inherently form pixels less than 150 microns. Regardless, Morgan et al teaches that it is desirable for ink jet printers to provide droplets with volumes less than 100 picoliters (and therefore which will inherently also produce pixels having diameters less than 150 microns) to provide smaller droplet sizes that produce higher resolution and higher print quality (column 1, lines 49-55). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the droplets of Doshi with volumes less than 100 picoliters and pixels with diameters less than 150 microns since Morgan et al teaches that it is desirable for ink jet printers to provide droplets with volumes less than 100 picoliters (and therefore which will

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inherently also form pixels having diameters less than 150 microns) to provide smaller droplet sizes that produce higher resolution and higher print quality.

It is believed that the nozzles of Doshi will inherently face perpendicular to the surface and in a hemisphere around the lens, this being reasonably based upon the similarity in structure between the ink jet printer of Doshi and that of the claimed invention. Doshi further discloses dispensing the droplets while rotating the lens (column 26, line 64); the droplets with a viscosity within the claimed range of claim 4 (column 12, lines 34-40). Furthermore, "commercially available ink jet printing devices" (column 8, line 24) will inherently dry within 5 seconds. Doshi further discloses printing a second pattern onto the lens (column 19, lines 56-60); coating the lens with a binding solution during the printing (column 7, lines 34-39, column 17, lines 4-9, column 18, line 37). The examiner takes Judicial Notice that it is well known in the art of colored contact lenses to apply binding solutions as coatings either during or after the coloring of the lens to bind to color to the substrate. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply a binder either during or after the coloring of the lens of Doshi since it is well known in the art of colored contact lenses to apply binding solutions as coatings either during or after the coloring of the lens to bind to color to the substrate. Doshi further discloses the colored pattern as an iris pattern of an eye (column 22, lines 31-39) but states that the invention is not limited to these images. The examiner takes Judicial Notice that it is well known in the art of contact lenses to apply as images on the contact lens surface, inversion marks, SKU codes or an identity code for the purpose of providing on the lens a required

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identification marking. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the image of Doshi as either an inversion mark, SKU code or an identity code since it is well known in the art of contact lenses to apply as images on the contact lens surface, inversion marks, SKU codes or an identity code for the purpose of providing on the lens a required identification marking.

### ***Prior Art Citations***

Ocampo publication number 2003/0025873 and 2003/0030772 are being cited herein to show methods that would read on claims 39 and 41, however, such rejections would have been repetitive. For applicant's information, numerous references, including DaCosta patent number 4,981,487 and Japanese document number 8-112566 would have also read on claims 39 and 41 but such rejections would also have been repetitive.

### ***Allowable Subject Matter***

Claims 13-14 and 57 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: with respect to the allowable subject matter, none of the prior art either alone or in combination disclose or teach the claimed combination of limitations. Specifically, with reference to claims 13-14, none of the prior art either alone or in combination disclose or teach of the claimed method of making a colored contact lens comprising the steps of transporting a contact lens into an ink jet printer having a plurality of

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nozzles, printing a pattern on the surface of a contact lens under control of a computer by dispensing droplets of a colorant onto the surface, the drops having a volume less than 100 picoliters and the printer capable of forming pixels less than 150 microns in diameter, coating the lens with a binding solution, and specifically further with the binding solution comprising at least one hydrophilic monomer and at least one hydrophobic monomer. Specifically, with reference to claim 57, none of the prior art either alone or in combination disclose or teach of the claimed colored contact lens produced by the process comprising the steps of transporting a contact lens into an ink jet printer having a plurality of nozzles, printing a pattern on the surface of the contact lens under control of a computer by dispensing droplets of a colorant onto the surface, the drops having a volume less than 100 picoliters and the printer capable of forming pixels less than 150 microns in diameter, the contact lens further comprising an iris pattern and a SKU code and specifically further with the SKU code blended with the iris pattern.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan M. Schwartz whose telephone number is (703) 308-1286. The examiner can normally be reached on Monday to Friday (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached at (703) 308-4883. The fax phone numbers for the organization where this application or proceeding is assigned are (703)



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308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

A handwritten signature in black ink, appearing to read 'JMS', with a large loop at the end.

Jordan M. Schwartz  
Primary Examiner  
Art Unit 2873  
August 29, 2003